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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,313	05/13/1999	JOHN G MCBRIDE	10971316-1	1086

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EXAMINER

GARBOWSKI, LEIGH M

ART UNIT

PAPER NUMBER

2825

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,313

Applicant(s)

MCBRIDE, JOHN G

Examiner

Leigh Marie Garbowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Taking claim 1 as exemplary, the claim does not appear to recite any features other than the concept already set out in the preamble. In other words, the body of the claim appears to be defined upon itself, the features of which were already recited in the preamble. It is not particularly clear what subject matter the applicant is claiming, thus rendering the claim is incomplete and vague.
4. The remaining claims, though not specifically mentioned, are rejected for incorporating the errors of their respective base claims by dependency.
5. The following rejections are based on the examiner's best interpretation of the claims in view of the issues raised above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
7. A person shall be entitled to a patent unless –
8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
9. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by

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another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuhns ["Automating Testability Analysis of Analog Circuits and Systems".
11. Taking claim 14 as exemplary [claims 1 and 19 are considered rejected but such is omitted for sake of brevity], Kuhns discloses a method for determining whether or not an element of a network comprised in an IC is a feedback element, the method comprising the step of: analyzing information relating to the network to determine whether or not an element comprised in the IC is a feedback element [page 230, "Testability Rules" section].
12. Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McElvain [U.S. Patent #6,182,268 B1]. Taking claim 14 as exemplary [claims 1 and 19 are considered rejected but such is omitted for sake of brevity], McElvain discloses a method for determining whether or not an element of a network comprised in an IC is a feedback element, the method comprising the step of: analyzing information relating to the network to determine whether or not an element comprised in the IC is a feedback element [column 6, lines 38-65; column 7, lines 15-16].

Allowable Subject Matter

13. Claims 2-13, 15-18, and 20-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter:

the prior art of record does not specifically disclose or teach a "field effect transistor" [claims 2-15] or a "particular type of circuit corresponding to a special case" [claims 11, 22] or a "recycle loop" [claim 20].

Remarks

1. Applicant's arguments filed 07 November 2001 have been fully considered but they are not persuasive.
2. Regarding the 35 U.S.C. 112, 2nd paragraph, rejections, the claims were not rejected "merely because the claimed preamble recites additional features" but because they are incomplete, ambiguous. Borrowing from the applicant's own illustration, if the Wright Brothers claimed a method for flying comprising the step of flying, would this particularly point out and distinctly claim the subject matter regarded as their invention? Accordingly, the examiner is not arguing the breadth of the claims, but actually the significance of the subject matter being defined upon itself such that a precise, clear, correct and unambiguous interpretation can thereof be made. Furthermore, the subsequent rejections based upon prior art are considered to elucidate this point.
3. Regarding the 35 U.S.C. 102 rejections, the applicant disagreed with the examiner's treatment of the apparatus, method and computer program claims as being coextensive. However, the applicant's own specification supports this basis of rejection: see page 8, lines 9-16. In other words, although the applicant can craft the language to purport to various enablements, the fact remains that the subject matter

is purely software/hardware. If the applicant believes that the invention comprises more specific subject matter, i.e. registers, buses, etc. that essentially serve to function the computer, the applicant is encouraged to claim such specific subject matter accordingly as supported in the specification.

4. Regarding the prior art references, it seems to the examiner that the applicant is not considering a broadest reasonable interpretation of the claimed subject matter in relation to the references applied. The applicant seems to be arguing that the references do not recite the exact language recited in the claims. The applicant may consider the entirety of the references in support of the specified citations. The examiner maintains that the references anticipate the subject matter of the claims as outlined above and further argued below.
5. Regarding the Kuhns reference, the applicant argues that the reference does not disclose "a method for determining whether or not an element within an integrated circuit is a feedback element." However, the examiner disagrees with the narrowly argued interpretation of the subject matter, especially since a broadest reasonable interpretation of the subject matter is customarily applied. The step recites "analyzing information relating to the network to determine whether or not an element comprised in the integrated circuit is a feedback element." Kuhns also disclose that the tool will search through the circuit to look for components, and the significance of identifying feedbacks loops is of particular note to prove that components can be of the feedback type. If the applicant prefers a more definitive interpretation of the claimed subject matter, the applicant is encouraged to recite

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such language, because although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

6. Regarding the Schuelein et al. reference, the rejection has been withdrawn because the examiner misinterpreted the significance of the floating type gate, as there is no suggestion in the reference that the associated transistors which appear to depict feedback in the drawings do in fact comprise feedback elements.
7. Regarding the McElvain reference, the examiner disagrees with the applicant that "there is absolutely no mention of a method for determining whether a given element is a feedback element." The reference even recites analyzing, identifying, searching, determining, etc, all terms which can be considered broadest reasonable interpretations of a step that purports to "analyzing information relating to the network..." It is not the mere mention of a feedback path, but the significance of the functioning being performed, which is to analyze, and the specific subject matter of a feedback element is clearly disclosed with such language as found in the reference. Again, it appears that the applicant is insisting upon a reference reciting the exact same language as the claims, instead of considering the broadest reasonable interpretation of the subject matter as claimed. Furthermore, the applicant is reminded that the rejections were based on the examiner's best interpretation of the subject matter in view of the 35 U.S.C. 112, 2nd paragraph, rejections applied.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
2. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Marie Garbowski whose telephone number is 703-305-9753. The examiner can normally be reached on days.
4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith can be reached on 703-308-1323. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.
5. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

✓ Leigh Marie Garbowski
April 19, 2002

NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

